

## **REMARKS/ARGUMENTS**

This Amendment responds to the Office Action dated June 21, 2010 in which the Examiner rejected claims 1-2, 4-6 and 8-11 under 35 U.S.C. § 103.

As indicated above, claims 1, 4 and 8-9 have been amended in order to make explicit what is implicit in the claims. The Amendment is unrelated to a statutory requirement for patentability.

Claims 1-2 and 8 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* (U.S. Patent No. 6,311,011) in view of *Lawler, et al.* (U.S. Patent No. 5,805,763) and *Ellis, et al.* (U.S. Publication No. 2003/0149988).

*Kuroda* appears to disclose a storage device 105 may be built-in a video recorder/player or be connected with the video recorder/player as a peripheral device (column 4, lines 42-44). Thus, nothing in *Kuroda* shows, teaches or suggests a connecting means/portion of a recording system connecting via an internet to an external device external to the recording system as claimed in claims 1 and 8. Rather, *Kuroda* only discloses a storage device 105 built in or connected as a peripheral device.

*Lawler, et al.* appears to disclose in Figure 1 an interactive viewing system is an interactive television system. The system 10 has a central head end 12 that supplies programming over a network 14 to multiple viewer stations 16 that are typically located in the homes of system users or subscribers (column 3, lines 29-34). The network 14 carries such bidirectional communication between the viewer station 16 and the head end 12. Alternatively, communication between the viewer station 16 and the head end 12 may be carried by different communication systems. For example, communication from the head end 12 to the viewer

station 16 can be carried on a satellite link while communication in the other direction is carried on a terrestrial modem link (column 5, lines 29-36, emphasis added).

Thus, *Lawler, et al.* only discloses a bidirectional communication between viewer station 16 and the head end 12. Nothing in *Lawler, et al.* shows, teaches or suggests (a) connecting via an internet with an external device which is external to the recording system, and (b) the external device separately receiving a program via a unidirectional communication from a distribution center independent of the recording system as claimed in claims 1 and 8. *Lawler, et al.* only discloses bidirectional communication.

*Ellis, et al.* appears to disclose communication paths 20 may be any communication paths suitable for distributing program guide data [0065].

Thus, *Ellis, et al.* only discloses distributing program guide data via communication paths. Nothing in *Ellis, et al.* shows, teaches or suggests (a) connecting via an internet with an external device which is external to the recording system, and (b) the external device separately receiving the program via unidirectional communication from the distribution center independently of the recording system as claimed in claims 1 and 8. Rather, *Ellis, et al.* only discloses communication paths suitable for distributing program guide data.

A combination of *Kuroda, Lawler, et al.* and *Ellis, et al.* would merely suggest to have storage device 105 connected with a video recorder/player as a peripheral device as taught by *Kuroda*, having a central head end 12 supplies programming over a network 14 to multiple viewer stations 16 by bi-directional communication as taught by *Lawler, et al.* and to distribute program guide data via communication paths as taught by *Ellis, et al.* Thus, nothing in the combination of the references shows, teaches or suggests (a) connecting via an internet with an external device which is external to the recording system, and (b) the external device separately

receiving the program via unidirectional communication from the distribution center independently of the recording system as claimed in claims 1 and 8. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 1 and 8 under 35 U.S.C. § 103.

Claim 2 depends from claim 1 and recites additional features. Applicants respectfully submit that claim 2 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Kuroda, Lawler, et al.* and *Ellis, et al.* at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 2 under 35 U.S.C. § 103.

Claims 4-6 and 9 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Ellis, et al.* and *Zigmond, et al.* (U.S. Patent No. 6,668,020).

As discussed above, *Kuroda* merely discloses connecting a storage device 105 to a video recorder/player as a peripheral device. Nothing in *Kuroda* shows, teaches or suggests (a) connecting via internet with external devices which are external to the recording substitution system and (b) the external devices include providing advertising information via the internet as claimed in claims 4 and 9. Rather, *Kuroda* only discloses a storage device connected with a video recorder/player as a peripheral device.

*Ellis, et al.* discloses an internet based interactive television program guide system using suitable combinations of hardware and software capable of providing program guide data to the guide [0069].

Thus, *Ellis, et al.* only discloses providing program guide information using the internet. Nothing in *Ellis, et al.* shows, teaches or suggests connecting via the internet with external devices which are external to the recording substitution system and from which advertising

information is obtained via the internet as claimed in claims 4 and 9. Rather, *Ellis, et al.* only discloses distributing the program guide via the internet.

*Zigmond, et al.* appears to disclose selecting appropriate advertisement based on at least whether the video programming feed is watched as it is broadcast or being replayed from recorded media. Advertisers can update time sensitive advertisement when such advertisements have been recorded. Originally recorded on videotape or other recorded media can be replaced with effectively targeted ads based on any other desired criteria (column 14, lines 1-12). The advertisement repository 86 may comprise conventional magnetic tape or any other recorded media for storing an analog version of the video programming feed (column 15, lines 31-34).

Thus, *Zigmond, et al.* merely discloses an advertisement repository. Nothing in *Zigmond, et al.* shows, teaches or suggests connecting via an internet with external devices from which advertising information is obtained via the internet as claimed in claims 4 and 9. Rather, *Zigmond, et al.* only discloses an advertisement repository.

A combination of *Kuroda, Ellis, et al.* and *Zigmond, et al.* would merely suggest to connect the storage device 105 as a peripheral device as taught by *Kuroda*, to provide the program guide via the internet as taught by *Ellis, et al.* and to have an advertisement repository as taught by *Zigmond, et al.* Thus, nothing in the combination of the references shows, teaches or suggests connecting via an internet with external devices which are external to the recording substitution system and from which advertising information is obtained via the internet as claimed in claims 4 and 9. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 4 and 9 under 35 U.S.C. § 103.

Claims 5-6 depend from claim 4 and recite additional features. Applicants respectfully submit that claims 5-6 would not have been obvious within the meaning of 35 U.S.C. § 103 over

*Kuroda, Ellis, et al.* and *Zigmond, et al.* at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 5-6 under 35 U.S.C. § 103.

Claims 10 and 11 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Lawler, et al.*, *Ellis, et al.* and *Zigmond, et al.*

Applicants respectfully traverse the Examiner's rejection of claims 10 and 11 under 35 U.S.C. § 103. The claims have been reviewed in light of the Office Action, and for reasons which will be set forth below, Applicants respectfully request the Examiner withdraws the rejection to the claims and allows the claims to issue.

As discussed above, since nothing in the combination of *Kuroda, Ellis, et al.* and *Lawler, et al.* show, teach or suggest the primary features as claimed in claim 1, Applicants respectfully submit that the combination of the primary references with the secondary reference to *Zigmond, et al.* will not overcome the deficiencies of the primary references. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claims 10 and 11 under 35 U.S.C. § 103.

Thus, it now appears that the application is in condition for a reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested. Should the Examiner find that the application is not now in condition for allowance, Applicants respectfully request the Examiner enters this Amendment for purposes of appeal.

**CONCLUSION**

If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is requested to contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 50-0320.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 50-0320.

Respectfully submitted,

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